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09/754,898	01/05/2001	Gary E. Clayton	10259-004	4774

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,898

Applicant(s)

CLAYTON ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 1-38 have been examined.

#### ***Claim Rejections - 35 USC §101***

Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 and 21 only recite an abstract idea. The recited steps of merely informing an individual about the disclosure of personal information, and verifying that this disclosure complies with local laws does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to inform an individual about the status of their privacy rights.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces consent from an individual (i.e., repeatable) in regards to the release of their private data (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5,7-9,16,17,19-27,34,35 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coueignoux (US Patent 6,092,197).

As per claim 1,

Coueignoux ('197) discloses a method for promoting compliance with data protection and privacy laws and regulations relating to the privacy rights of individual; that comprises:

informing an individual involved in potential disclosure of his/her personal data to an entity that the entity has certified its compliance with :approved privacy and data security practices that conform to relevant data protection and privacy laws and regulations covering the use of personal data in at least the individual's or entity's country of location;(Column 2, lines 39-61)

obtaining the individual's consent to have the entity receive, or acknowledgment that the entity will receive, and use his/her personal data in accordance with a stated policy or with relevant data protection and privacy laws and regulations covering a use of personal data m at least the individual's or the entity's country of location; (Column 3, lines 15-28)

transmitting to the entity data indicating that t 7c individual has been informed of the entity's privacy practices and consented to the entity receiving, or acknowledged that the entity will be receiving, and using his/her personal data in accordance with its stated policy or with relevant data protection and privacy laws and regulations covering the use of personal data in at least the individual's or the entity's country a location;(Column 2, lines 39-61)

receiving from the entity data comprising per, personal data collected by the entity from the individual; storing said personal data received from the entity; (Figure 1)

Official Notice is taken that "periodically checking whether the entity has complied with the stated policy or with relevant data protection and privacy laws and regulation covering the use of personal data in at least the individual's or the entity's country of location." is common and well known in prior art in reference to compliance with data protection and privacy laws. It would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check whether the entity has complied with the stated policy or with relevant data protection and privacy laws and regulation covering the use of personal data in at least the individual's or the entity's country of location in order to in order to allow the entity to correct any inadvertent violations of privacy laws that might have occurred

As per claim 2,

Coueignoux ('197) discloses a method according to claim 1.

Official Notice is taken that " informing the individual that the entity is covered by insurance or equivalent risk: instrument to protect against risk of loss of harm caused to the individual arising from misuse or loss of the individual's personal data by the entity." is common and well known in prior art in reference to compliance with data protection and privacy laws. It would have been obvious to one having ordinary skill in the art at the time the invention was made to inform the individual that the entity is covered by insurance or equivalent risk: instrument to protect against risk of loss of harm caused to the individual arising from misuse or loss of the individual's personal data by the entity in order to in order to promote consumer confidence in the system.

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As per claim 3,  
Coueignoux ('197) discloses a method according to claim 1  
wherein said data indicating that the individual has consented to have the entity receive,  
or acknowledgment that the entity will receive, and use the individual's personal data comprises  
data uniquely identifying details relating to the individual's consent.(Column 5, lines 44-64)

As per claim 4,  
Coueignoux ('197) discloses a method according to claim 3  
wherein said data indicating that the individual has consented to have the entity receive,  
or acknowledgement that the entity will receive, and use the individual's personal data and  
uniquely identifying details relating to the individual's consent is compressed using a hash  
function.(Column 13, lines 43-51)

As per claim 5,  
Coueignoux ('197) discloses a method according to claim 4  
wherein said data received from the entity comprising personal data collected by the  
entity from the individual. includes the data transmitted to the entity uniquely identifying details  
relating to the individual's consent.(Column 6, lines 59-62)

As per claim 7,  
Coueignoux ('197) discloses a method according to claim 1  
Official Notice is taken that "performed with a multiplicity of entities and individuals  
located in a multiplicity of countries" is common and well known in prior art in reference to  
compliance with data protection and privacy laws. It would have been obvious to one having  
ordinary skill in the art at the time the invention was made to perform with a multiplicity of  
entities and individuals located in a multiplicity of countries in order to maximize efficiency by  
processing multiple entities at a single time.

As per claim 8,  
Coueignoux ('197) discloses a method according to claim 1  
Official Notice is taken that "the individual is informed in an official language of the  
individual's country of location" is common and well known in prior art in reference to  
compliance with data protection and privacy laws. It would have been obvious to one having  
ordinary skill in the art at the time the invention was made to inform the individual in an official  
language of the individual's country of location in order to allow the individual to comprehend  
the message, and provide a useful service.

As per claim 9,  
Coueignoux ('197) discloses a method according to claim 1  
conducted as a multi-entity privacy policy certification program requiring member  
entities to certify compliance with approved privacy standards for the use of personal data of  
individuals and providing such entities with a policy notice to confirm their approval by, and  
membership in, the program.(Column 2, lines 39-61)

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As per claim 16,

Coueignoux ('197) discloses a method according to claim 1

Wherein the data received from the entity comprising the individual's stored personal data includes the time period of the individual's consent or acknowledgment, the length of time that the individual's personal data will be retained, and an option to extend or renew the individual's consent or acknowledgment, if desired, notice thereof being provided to the entity and to the individual in advance of expiration of the consent.(Column 5, lines 44-64)

As per claim 17,

Coueignoux ('197) discloses a method according to claim 16

wherein the individual is provided with the option of having the individual's personal data deleted from the entity's data storage upon expiration of the agreement.(Column 16, lines 43-56)

As per claim 19,

Coueignoux ('197) discloses a method according to claim 1,

wherein the steps of informing the individual, obtaining the individual's consent or acknowledgment, transmitting data to the entity, and receiving data from the entity are performed over a computer network.(Figure 1)

As per claim 19,

Coueignoux ('197) discloses a method according to claim 19,

wherein the computer network is the Internet.(Figure 1)

As per claim 21,

Coueignoux ('197) discloses a system for promoting compliance with data protection and privacy laws and regulations relating to the privacy rights of individual; that comprises:

means for informing an individual involved in potential disclosure of his/her personal data to an entity that the entity has certified its compliance with approved privacy and data security practices that conform to relevant data protection and privacy laws and regulations covering the use of personal data in at least the individual's or the entity's country of location;(Column 2, lines 39-61)

means for obtaining the individual's consent to have the entity receive, or acknowledgment that the entity will receive, and use of his/her personal data in accordance with a stated policy or with relevant data protection and privacy laws and regulations covering the use of personal data in at least the individual's or the entity's country of location;(Column 3, lines 15-28)

means for transmitting to the entity data indicating that the individual has been informed of the entity's privacy practices and consent to the entity, receiving, or acknowledgment that the entity will be receiving, and using his/her personal data in accordance with its stated policy or with relevant data protection and privacy laws and regulations covering the use of personal data in at least the individual's or the entity's country of location;(Column 2, lines 39-61)

means for receiving from the entity data comprising personal data collected by the entity from the individual and means for storing said personal data received from the entity;(Figure 1)

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Official Notice is taken that “periodically checking whether the entity has complied with the stated policy or with relevant data protection and privacy laws and regulation covering the use of personal data in at least the individual's or the entity's country of location.” is common and well known in prior art in reference to compliance with data protection and privacy laws. It would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check whether the entity has complied with the stated policy or with relevant data protection and privacy laws and regulation covering the use of personal data in at least the individual's or the entity's country of location in order to in order to allow the entity to correct any inadvertent violations of privacy laws that might have occurred

As per claim 22,

Coueignoux ('197) discloses a system according to claim 21.

Official Notice is taken that “informing the individual that the entity is covered by insurance or equivalent risk: instrument to protect against risk of loss of harm caused to the individual arising from misuse or loss of the individual's personal data by the entity.” is common and well known in prior art in reference to compliance with data protection and privacy laws. It would have been obvious to one having ordinary skill in the art at the time the invention was made to inform the individual that the entity is covered by insurance or equivalent risk: instrument to protect against risk of loss of harm caused to the individual arising from misuse or loss of the individual's personal data by the entity in order to in order to promote consumer confidence in the system.

As per claim 23,

Coueignoux ('197) discloses a system according to claim 21

wherein said data indicating that the individual has consented to have the entity receive, or acknowledgment that the entity will receive, and use the individual's personal data comprises data uniquely identifying details relating to the individual's consent.(Column 5, lines 44-64)

As per claim 24,

Coueignoux ('197) discloses a system according to claim 23

wherein said data indicating that the individual has consented to have the entity receive, or acknowledgement that the entity will receive, and use the individual's personal data and uniquely identifying details relating to the individual's consent is compressed using a hash function.(Column 13, lines 43-51)

As per claim 25,

Coueignoux ('197) discloses a system according to claim 24

wherein said data received from the entity comprising personal data collected by the entity from the individual. includes the data transmitted to the entity uniquely identifying details relating to the individual's consent.(Column 6, lines 59-62)

As per claim 26,

Coueignoux ('197) discloses a system according to claim 21

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Official Notice is taken that "the individual is informed in an official language of the individual's country of location" is common and well known in prior art in reference to compliance with data protection and privacy laws. It would have been obvious to one having ordinary skill in the art at the time the invention was made to inform the individual in an official language of the individual's country of location in order to allow the individual to comprehend the message, and provide a useful service.

As per claim 27,  
Coueignoux ('197) discloses a system according to claim 21  
conducted as a multi-entity privacy policy certification program requiring member entities to certify compliance with approved privacy standards for the use of personal data of individuals and providing such entities with a policy notice to confirm their approval by, and membership in, the program.(Column 2, lines 39-61)

As per claim 34,  
Coueignoux ('197) discloses a system according to claim 21  
Wherein the data received from the entity comprising the individual's stored personal data includes the time period of the individual's consent or acknowledgment, the length of time that the individual's personal data will be retained, and an option to extend or renew the individual's consent or acknowledgment, if desired, notice thereof being provided to the entity and the individual in advance of expiration of the consent.(Column 5, lines 44-64)

As per claim 35,  
Coueignoux ('197) discloses a system according to claim 34  
wherein the individual is provided with the option of having the individual's personal data deleted from the entity's data storage upon expiration of the agreement.(Column 16, lines 43-56)

As per claim 37,  
Coueignoux ('197) discloses a system according to claim 21,  
wherein the steps of informing the individual, obtaining the individual's consent or acknowledgment, transmitting data to the entity, and receiving data from the entity are performed over a computer network.(Figure 1)

As per claim 38,  
Coueignoux ('197) discloses a system according to claim 37,  
wherein the computer network is the Internet.(Figure 1)

Claims 6,10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coueignoux (US Patent 6,092,197) in view of Clayton et al. (US Patent application 09/754898)

As per claim 6,  
Coueignoux ('197) discloses a method according to claim 1



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Coueignoux ('197) does not explicitly disclose "performed with a multiplicity of entities and individuals located in a single country", Clayton et al. discloses "performed with a multiplicity of entities and individuals located in a single country".( Page 2, lines 26-28) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Coueignoux ('197) method with the Clayton et al. method in order to maximize efficiency by processing multiple entities at a single time.

As per claim 10,

Coueignoux ('197) discloses a method according to claim 9

Coueignoux ('197) does not explicitly disclose "the approved standards meet the standards required by the United States, European Union, or other countries or regional organizations.", Clayton et al. discloses "the approved standards meet the standards required by the United States, European Union, or other countries or regional organizations".( Page 1, lines 28-31) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Coueignoux ('197) method with the Clayton et al. method in order in order to allow the individual to provide a useful service.

As per claim 28,

Coueignoux ('197) discloses a system according to claim 27

Coueignoux ('197) does not explicitly disclose "the approved standards meet the standards required by the United States, European Union, or other countries or regional organizations.", Clayton et al. discloses "the approved standards meet the standards required by the United States, European Union, or other countries or regional organizations".( Page 1, lines 28-31) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Coueignoux ('197) method with the Clayton et al. method in order in order to allow the individual to provide a useful service.

### ***Allowable Subject Matter***

Claims 11-15,18,29-33 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

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respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

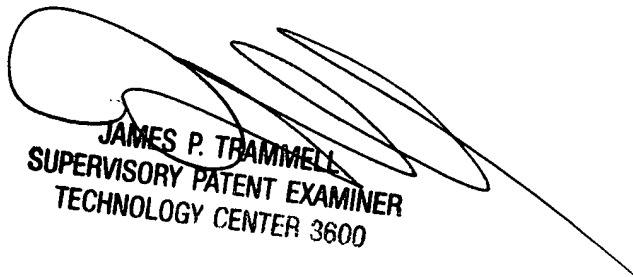
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

May 15, 2003



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600